

REMARKS

It is acknowledged that Claims 15 and 16 are allowable; thus, the Examiner has admitted that the claimed embodiments satisfy 35 USC §§ 102, 103, and 112.

Rejected Claims Satisfy 35 USC § 112

Apparently, the Examiner argues that the terms “therapeutically effective amount” renders Claims 22 indefinite. The Applicants disagree. Claims are indefinite when, read in light of the specification, they do not reasonably apprise those skilled in the art of the scope of the invention. *Howmedia Osteonics v. Tranquil Prospects*, 401 F.3d 1367, 1371 (Fed. Cir. 2005). However, the claims must be so insolubly ambiguous that no narrowing construction can properly be adopted. When a claim “is not insolubly ambiguous, it is not invalid for indefiniteness.” *Bancorp v. Hartford Life*, 359 F.3d 1367, 1372 (Fed. Cir. 2004). As provided by the Court of Appeals for the Federal Circuit in *Amgen v. Hoechst* 314 F.3d 1313 (Fed. Cir. 2003):

The standard of indefiniteness is somewhat high; a claim is not indefinite merely because its scope is not ascertainable from the face of the claims. Cf., e.g., *LNP Eng’g Plastics, Inc. v. Miller Waste Mills, Inc.*, 275 F.3d 1347, 1359-60, 61 USPQ2d 1193, 1202 (Fed. Cir. 2001) (affirming district court finding that patent was not indefinite, despite testimony from a co-inventor that he did not understand what the claim limitation “substantially completely wetted” meant). Rather, a claim is indefinite under § 112 ¶ 2 if it is “insolubly ambiguous, and no narrowing construction can properly be adopted.” *Exxon Research & Eng’g Co. v. United States*, 265 F.3d 1371, 1375, 60 USPQ2d 1272, 1276 (Fed. Cir. 2001); *Allen Eng’g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1349, 63 USPQ2d 1769, 1776 (Fed. Cir. 2002)

See also in *Amgen v. Hoechst* (Fed. Cir. 2006) pages 3-4. “We remanded the case to the district court to do the following: (i) construe the term ‘therapeutically effective amount’ in claim 1 . . . the district court construed the term ‘therapeutically effective amount’ in claim 1”

The terms “therapeutically effective amount” satisfy 35 USC § 112.

With regard to Claim 25, the Examiner has neither pointed to any specific language that is indefinite, nor do any combination of terms result in an ambiguity. Thus, Applicants disagree that any particular claim term is indefinite or that Claim 25 itself as a whole is indefinite. In any case, in order to further prosecution, and in no way acquiescing to the Examiner's rejection, hereby expressly reserving the right to prosecute the same or similar claims, Claim 25 has been amended to recite the preparation of compounds as provided for in the preamble.

For the reasons stated hereinbefore, it is believed the instant amendment puts the case in condition for allowance and a notice to that effect is earnestly solicited. Although Applicants believe no additional fees are due, the Commissioner is hereby authorized to charge any deficiency in the fees or credit any overpayment to deposit account No. 50-3231, referencing Attorney Docket No. 100653-1P US.

Respectfully submitted,

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